

REMARKS

Favorable reconsideration is respectfully requested in view of the preceding amendments and the following remarks.

Amendment to the Specification

The "Related Applications" paragraph has been replaced. Applicants previously claimed benefit of U.S. Serial No. 08/883,218, filed June 26, 1997 (to which the instant application is a continuation in part) which is a divisional of U.S. Serial No. 08/708,574, filed September 5, 1996, now U.S. Patent No. 5,916,911, which claimed priority from U.S. Serial No. 60/004,047, filed September 20, 1995. By this deletion, Applicants hereby cancel their claim to priority to these applications.

The replacement "Related Applications" paragraph includes references to applications to which applicants previously claimed benefit of priority, but which were not earlier added in a formal amendment. The instant application, as amended, claims benefit of priority to PCT/US00/18935, filed July 7, 2000, to which the instant application is a U.S. National filing under 35 U.S.C. § 371. This claim was previously made and was acknowledged in a filing receipt mailed by the U.S. PTO on March 29, 2002, with confirmation number 2781. Benefit of priority in the instant application, as amended, is also claimed to U.S. Serial No. 09/350,768, filed July 9, 1999, now U.S. Patent No. 6,255,336. This claim was previously made in PCT/US00/18935 published as WO 01/04108. No new matter is added by this amendment.

Amendments to the Claims

Claims 1-13 and 15-17 have been cancelled. Applicants reserve the right to file a continuation application or take other such action to preserve rights to the embodiments of the cancelled claims or other unclaimed embodiments disclosed in the instant application.

In Claim 14, a typographical error is amended by inserting an apostrophe in the name of the compound "D-*t*-4'-hydroxy-1-phenyl-2-palmitoylamino-3-pyrrolidino-1-propanol". Claim 14 has been amended to remove the term "functional homologues" and amend the term "isomer" to "stereoisomer". Support can be found in the application as filed on page 6, lines 10-12, which states that "All four structural isomers of the compounds are contemplated within the present

invention and may be used either singly or in combination (i.e., DL-threo or DL-erythro)", which phrase one skilled in the art will understand as equivalent to the term "stereoisomer". Also, the phrase "a composition comprising" has been deleted. Further, the phrase ", wherein the infection is characterized by binding of the microbe, the virus, or a toxin thereof to glycosphingolipids of the patient's cells" has been added. Support can be found on page 9, lines 3-15. New Claim 18 has been added, incorporating the specific infections found on page 9. New Claims 19 and 20 have been added which are specific to each compound or a pharmaceutically acceptable salt thereof present in Claim 14. No new matter is added by these amendments.

Rejections under obviousness-type double patenting

In Paragraph 3, the Examiner rejected Claims 1-7 under the judicially created doctrine of obviousness-type double patenting. Because Claims 1-7 have been cancelled, Applicants respectfully request that rejections directed to these claims be withdrawn.

In paragraph 4, the Examiner rejected Claims 8-17 in part under the judicially created doctrine of obviousness-type double patenting over U.S. Patent Nos. 5,916,911, 5,945,217, 5,952,370, 6,040,332, and 6,051,598. Because Claims 10-13 and 15-17 have been cancelled, Applicants respectfully request that the rejection be withdrawn for these Claims.

Of the references cited by the Examiner, only Claims 1-5 of U.S. Patent No. 6,040,332 (hereinafter the '332 patent) are directed to a method for treating a patient having a microbial or viral infection. Claim 14 of the present application is directed to a method for treating a patient having a microbial or viral infection using the compounds D-*t*-3', 4'-ethylenedioxy-1-phenyl-2-palmitoylamino-3-pyrrolidino-1-propanol, D-*t*-4'-hydroxy-1-phenyl-2-palmitoylamino-3-pyrrolidino-1-propanol and stereoisomers and pharmaceutically acceptable salts thereof (emphasis added). Thus, in the compounds encompassed by the present claims, the highlighted phenyl group is substituted with either 4'-hydroxy or 3',4'-ethylenedioxy. However, R1, the corresponding group in the compounds recited in the claims of the '332 Patent, is an "aromatic structure" The claims of the '332 Patent do not disclose or suggest phenyl substituted with either 4'-hydroxy or 3',4'-ethylenedioxy. Absent any teaching or suggestion in the prior art of replacing "an aromatic group" with a phenyl substituted with a 4'-hydroxy group or a 3',4'-ethylenedioxy group, Claim 14 is nonobvious and thus patentable over the prior art. Further, the

specification of the '332 patent does not teach these two new substituents, and there is no suggestion that they are equivalent to the substituents that are taught. Thus, instant Claim 14 is also nonobvious over the specification of the '332 patent. Therefore, withdrawal of the rejection is respectfully requested.

In paragraphs 5 and 6, the Examiner provisionally rejects Claims 1-13, 15, and 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/134,315. Because these claims have been cancelled, Applicants respectfully request the rejection be withdrawn.

In paragraph 7, Claims 1-3, 5, and 7-17 were rejected under U.S.C. § 112, second paragraph. Because Claims 1-3, 5, 7-13, and 15-17 have been cancelled, Applicants respectfully request the rejection be withdrawn for these Claims. In Claim 14, terms the Examiner regarded as indefinite have been deleted ("functional homologs") or amended ("isomers" to "stereoisomers", supported in the application as described above). The rejection is believed to be overcome and Applicants respectfully request the rejection be withdrawn.

CONCLUSION

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By 
Steven G. Davis
Registration No. 39,652
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133

Dated:

April 23 2004